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IN THE
Supreme Court of the United States
OCTOBER TERM, 1940

No. 666

DETROLA RADIO AND TELEVISION
CORPORATION,

Petitioner,

vs.

HAZELTINE CORPORATION,

Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION
TO PETITION FOR CERTIORARI**

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Statement of the Case.

In the following statement of respondent's position important inaccuracies or omissions in petitioner's statement of the matter involved are mentioned.

I. Petitioner's Point I rests upon the assertion that there is a direct conflict between the Circuit Courts of Appeals for the Sixth and Second Circuits. There is in fact no such conflict.

The subject matter adjudicated by the Second Circuit Court of Appeals in the *Abrams* case, 79 F. (2d) 329, affirming 7 F. Supp. 908, was the validity of claims 1, 5, 6 and 10 of the original patent to Wheeler 1,879,863 issued September 27, 1932. These claims, which defined a relatively basic monopoly in a rapidly developing branch of the radio art, were held void for lack of invention over earlier patents to Affel 1,574,780, Bjornson 1,666,676 and Heising 1,687,245.

The subject matter adjudicated by the Sixth Circuit Court of Appeals in the instant case (R. 1470-80) affirming the interlocutory judgment of the District Court for the Eastern District of Michigan (Lederle, J., R. 838-61) was the validity of restricted claims 1 to 7 inclusive and 9 to 13 inclusive of the Reissue patent 19,744 granted October 29, 1935. After the decision in the Second Circuit and prior to the litigation in the Sixth Circuit the original patent was surrendered, the relatively basic monopoly defined in original claims 1, 5, 6 and 10 was disclaimed, and the patent was reissued with restricted claims directed to a specific combination of electrical elements disclosed in the original patent specification but not adequately claimed in the original claims.

In the Sixth Circuit case, which petitioner now seeks to bring into this Court by certiorari, these restricted claims of the reissued patent were upheld by the District Court on findings of fact as to the novelty and utility of the specific combination defined in the reissue claims, and its relation to the nearest disclosure of the prior art—the disclosure of Evans patents 1,736,852 and 1,869,323 (R. 854-5, Findings 20, 22). The interlocutory judgment of the District Court was affirmed by the Sixth Circuit Court of Appeals (R. 1470) in an opinion which reviews the facts as to the novelty and utility of this specific combination and its relation to the disclosure of the Evans patents (R. 1476-80). The more closely the two opinions are examined, the more clearly will it appear that there is no conflict be-

tween them. We have attempted to facilitate such examination, by a condensed statement of the issues in the two cases, in our "Argument" (*post*, pp. 5-11).

II. Petitioner's Point II asserts that the Sixth Circuit Court of Appeals held, in effect, "that want of invention in the disclosure of an original patent is a defect which can be cured by a reissuance thereof".

The Sixth Circuit Court of Appeals made no such holding, as must be apparent upon a moment's consideration of the assertion. If no invention had been disclosed in the original patent specification that deficiency could be cured only by adding new matter to the original disclosure. It is not pretended that any new matter was introduced into the Wheeler specification by the reissue (see the Sixth Circuit Court of Appeals Opinion, R. 1474, and the District Court Finding 18, R. 844). The error in petitioner's Point II is derived from a quite erroneous assertion (petition, p. 2, par. 2) that the decision of the Second Circuit Court of Appeals was to the effect that the original patent specification failed to disclose a patentable invention. The decision did not in fact go beyond the novelty and validity of the subject matter broadly defined in original claims 1, 5, 6, and 10. There was no occasion for the Second Circuit Court of Appeals to pass upon the patentability of the more specific subject matter of the reissued claims, and it did not do so. The distinction is one which the courts have had no difficulty in observing, although petitioner's counsel seems unable to do so (see *post*, pp. 11-13).

III. Petitioner's Point III is quite ambiguously stated, but from petitioner's Argument on page 12 it may be gathered that it rests upon the assertion that the "inadvertence, accident or mistake" in the original patent was "created *solely and nunc pro tunc* by the adverse decision of the Court of Appeals for the Second Circuit". The fact is that the "inadvertence, accident or mistake" re-

sided in the fact that Wheeler unintentionally and in reliance upon his solicitor drafted or accepted claims not commensurate with the invention disclosed in the specification. That this was done "honestly without fraudulent or deceptive intention, and without intending to claim as Wheeler's invention or discovery more than he had a right to claim as new" was established by a finding of fact in the District Court *agreed to by both parties* (Finding 19, R. 844-5, and Court of Appeals Opinion, R. 1475).

It is not contended that there is, between decisions of the several Courts of Appeals or between the decision of the Sixth Circuit Court of Appeals and any decision of this Court, any conflict as to the rule that such circumstances constitute inadvertence within the meaning of the statute (see *post*, pp. 13-15).

IV. Petitioner's Point IV, based on the assertion that the Wheeler reissue patent "is advanced as dominating the entire field of radio broadcast-receiving-set manufacture" also lacks factual support.

The monopoly defined in the restricted claims of the Wheeler reissued patent is a quite specific arrangement of electrical circuit elements affording a particular means for automatically controlling the amplification (sound volume) in broadcast radio receivers. There are other available ways of making broadcast radio receivers with automatic amplification (sound volume) control. These other ways are disclosed in numerous patents owned or controlled by Radio Corporation of America, including the patents of Evans, Affel, Friis and others. Most of the substantial manufacturers of radio receiving apparatus in the United States, including defendant, are licensed to use these patented arrangements (Stipulation, R. 217). Defendant, and substantially all other manufacturers of radio receiving apparatus in the United States, have chosen to use the Wheeler arrangement in preference to these other

available arrangements (R. 853, Finding 18), but that is a matter of choosing to use a very specific improvement, not a matter of "dominating the entire field of radio broadcast receiving-set manufacture."

ARGUMENT.

I. There is no conflict between the decision of the Sixth Circuit Court of Appeals in the instant case and the decision of the Second Circuit Court of Appeals in the Abrams case.

The new combination of electrical elements, which the Sixth Circuit Court of Appeals has held to be a patentable invention, is an automatic volume control system for broadcast radio receivers essentially characterized by the fact that the automatic volume control potential is secured directly from the amplified signal itself by means of a diode (two electrode) rectifier having a high resistance connected between its anode and the cathode of the controlled amplifier (cf. claim 1 of the Reissue patent).¹

¹Claim 1 of Reissue Patent 19,744: (R. 872)

"1. In a signal receiver having a carrier-frequency amplifier which includes at least one vacuum tube having a cathode and a control electrode, a two-electrode rectifier coupled to the output circuit of said amplifier, a high resistance connected between the rectifier anode and the amplifier cathode, means including said resistance for maintaining the average potential of said anode normally negative relative to at least part of said amplifier cathode and increasingly negative with increasing amplified signal output from said amplifier, and a direct-current connection from said anode back to said amplifier control electrode whereby the amplification of said amplifier is regulated automatically."

That this was the specific subject matter adjudicated by the District Court in the instant case appears from the findings of that court, the pertinent parts of which are quoted in the margin.²

²Extracts from Judge Lederle's Findings: (R. 850, 853-5)

"10. Wheeler then changed the receiver by eliminating a triode rectifier with its separate batteries which had to be critically adjusted and used the two-electrode (diode rectifier), with high resistance in its external circuit which he had devised on December 17, 1925. . . ."

"18. . . . Wheeler's invention marks a distinct advance in the art and it has solved a practical difficulty in radio receiving equipment which is of great benefit to the public."

"20. . . . The nearest approximation to Wheeler is the disclosure of the Evans patents 1,736,852 and 1,869,323. In the Evans disclosure the direct current potential for biasing the amplifier grid is not as in Wheeler produced directly from the amplified and rectified signal but is derived from a source of energy in the plate circuit of a triode rectifier . . . controlled by applying the amplified modulated signal to the grid circuit of the triode rectifier. The control potential in the Evans arrangement is critically dependent upon the adjustment of the B battery and the C battery of the triode rectifier and, because the triode rectifier has a non-linear characteristic . . . the direct current biasing potential and hence the automatic volume control [is] . . . affected by the degree of modulation of the signal; and the system therefore impairs the desired contrast of the signal."

"22. . . . I am forced to conclude that the Wheeler system marks a new and useful improvement in the radio art requiring an exercise of inventive genius and that no mere mechanic skilled in this art, as it existed in 1925, would have been able to have developed it."

The Sixth Circuit Court of Appeals affirmed the decision of the District Court on this specific ground, with a full discussion of this essential and restricted characteristic of the invention defined in the reissue claims. Pertinent extracts from the opinion by Judge Allen are quoted in the margin.³

³Extract from Opinion of the Sixth Circuit Court of Appeals:
(R. 1478-80)

"Appellant urges that there is no invention in the use of the diode as opposed to the triode; but Wheeler's device does not merely embody the diode. It discloses the use of the diode united with a high external resistance opposed to the relatively low internal resistance of the diode, with a consequent linear response which results in better automatic volume control than had ever before been secured. We agree with the District Court that this combination of the diode and the high resistance creating the negative bias at the grid in direct proportion to the amplified modulated carrier voltage is a new and useful improvement in the radio art, requiring the exercise of inventive genius. The device secures automatic volume control. The elements of the combination were old, but the combination was new, and the result was new. This constitutes invention. *Forestek Plating & Mfg. Co. v. Knapp-Monarch Co.*, 106 Fed. (2d) 554, 557 (C. C. A. 6).

In the triode, energy is obtained from an external source or battery, and not from the amplified signal. The control bias voltage is dependent upon the battery voltage. Therefore, in the three-electrode detector circuits, an adjustment must be made in order to increase or decrease the requisite amplification to compensate for variations of signal strength. In Wheeler, the resistance which is high compared with the resistance of the diode, makes the diode a minor element in determining the voltage of the rectified signal. This rec-

(Footnote continued on next page.)

The claims of the original patent adjudicated by the Second Circuit Court of Appeals were of much broader scope. They did not present the issue of fact or law adjudicated in the Sixth Circuit. Claims 1, 5 and 6 were not restricted to the diode form of detector, and though claim 10 was restricted to the diode form of detector it did not include the high resistance connected between the anode of the rectifier and the cathode of the controlled amplifier. (See the Opinion of the District Court for the Eastern District of New York in the *Abrams case*, 7 F. Supp. 908 at page 913, second column, and compare

(Footnote continued from previous page.)

ord supports the assertion of the specifications that as the diode rectifier does not amplify, is not critical, and requires neither anode nor biasing battery. Wheeler requires no adjusting device, such as a potentiometer, to accommodate the control bias to any particular combination of tubes and B battery voltage.

Another important feature of Wheeler is that the device secures linear response. Since the control voltage is derived directly from the amplified signal, it is always directly proportional to the amplified signal voltage, and the 'average signal amplitude which is equal to the carrier wave amplitude and independent of the degree of modulation' is kept constant. But in a triode such as was used at the time of Wheeler's invention, the rectified voltage was proportional to the square of the applied voltage, and not directly. It was admitted by Kelly, appellant's expert, that a diode detector used in series with the high resistance gives linear response, that the use of the triode results in a 'square law action,' and that to get any linear characteristic using a triode, both the B battery potential and the C battery potential have to be increased. He could not recall any radio receiver using a triode that was linear in its action. These distinct changes in operation work a substantial advance in automatic volume control."

claims 1 and 10 of the original patent quoted in the margin⁴ with claim 1 of the Reissued patent quoted *ante* p. 5.)

As to this, the Sixth Circuit Court of Appeals said (R. 1476):

"... claim 1 of the reissue patent is not in substance the same as claim 10 of the original patent. In addition to what was formerly described, claim 1 adds the essential element of the 'high resistance connected between the rectifier anode and the amplifier cathode.' "

Original claims 1, 5, and 6 were directed broadly to a system of automatic volume control in which there was created and maintained a negative biasing potential which would become increasingly negative in the presence of an amplified

⁴Claims 1 and 10 of the original Wheeler patent (R. 1074A-1075) adjudicated in the Second Circuit:

"1. In a signaling system a vacuum tube amplifier having a cathode and a control electrode, a vacuum tube detector coupled to said amplifier, said detector having an output electrode, means for maintaining said output electrode normally negative relative to at least part of said amplifier cathode, means for causing said output electrode to become more negative in the presence of an amplified signal, and a direct-current connection between said control electrode and said output electrode, whereby the amplification of said amplifier is regulated automatically."

"10. In a signaling system, a vacuum tube amplifier having a cathode and a control electrode, a diode detector coupled to said amplifier, said detector having an anode, means for maintaining said anode normally negative relative to at least part of said amplifier cathode, means for causing said anode to become more negative in the presence of an amplified signal, and a direct-current connection between said control electrode and said anode, whereby the amplification of said amplifier is regulated automatically."

signal and which was applied through a direct current connection to the control electrode (grid) of the controlled amplifier (see 7 F. Supp. 911, 2nd column, and 913, 2nd column). This broad subject matter was found by the District Court in the *Abrams* case in Affel's patent 1,574,780 (7 F. Supp. 913, 1st column). Plaintiff in that case sought to differentiate the broad claims from ~~the~~ prior patents in three ways, and asked the court to read three limitations into the claims from the specification. These were (1) a limitation to a receiver as distinguished from a transmitter; (2) a time delay provision in the direct current connection from the rectifier to the controlled amplifier; and (3) the application of the control potential to an amplifier which precedes the rectifier, as distinguished from the application of the control to an amplifier which follows the rectifier. This was referred to as a distinction between "regressive" and "progressive" amplification. These differentiations impressed the District Court but it felt unable to interpret the claims with that degree of flexibility (see 7 F. Supp. 914). The Second Circuit Court of Appeals reached the same result by a somewhat different course (79 F. [2d] 329, 2nd column). It was not inclined to interpret the claims so rigidly, but found it unnecessary to decide whether the original claims should be limited in *these three respects* "because even if we read them as the plaintiff wishes, we think that there was no invention" in view of Affel's patent 1,574,780, Bjornson's patent 1,666,676, and Heising's patent 1,687,245 (79 F. [2d] 330-1).

Thus, the novelty and patentability of the particular combination of elements defined in the restricted claims of the reissue patent was not adjudicated in the Second Circuit Court of Appeals, and there is no conflict between the decision of that Court in the *Abrams* case and the decision of the Sixth Circuit Court of Appeals in the instant case.

II. The Sixth Circuit Court of Appeals has not "held, in effect, that want of invention in the disclosure of an original patent is a defect which can be cured by a reissuance thereof," or otherwise departed from well established precedents.

When the subject matter litigated in the Second Circuit is thus critically examined, it is seen that the Second Circuit Court of Appeals did not decide that there was no invention disclosed in the original patent specification. Petitioner's assertion to that effect is utterly without foundation. Petitioner's counsel seem unable to differentiate between a case (and there have been such cases) in which a court has examined the whole content of the original patent specification and has held that there was no invention disclosed in it, and a case like the present one in which the adjudication of the original patent was limited to the examination of the patentability of broad claims in the original patent. The courts have not found any difficulty in making that differentiation. It was made as early as 1885 in the opinion by Judge Brown of the Eastern District of Michigan in *Mathews v. Flower*, 25 Fed. 830, where he distinguished from the decision by Judge Bond in the District of Maryland in *Jones v. McMurray*, 2 Hughes 527 (1877), 13 F. Cas. 989 (No. 7479). And the distinction has recently been observed and applied in *Rolscreen Co. v. Abraham & Straus, Inc.*, 38 USPQ 523, August, 1938, D. C. E. D. N. Y.*

In the course of their argument, petitioner's counsel assert (petition p. 11) that if the decision of the Sixth Circuit Court of Appeals in the instant case is allowed to stand it will be an approval of the exercise by the Commissioner of Patents of "power, in *ex parte* proceedings before him, to review and set aside decisions of the Federal Courts of Appeals". The fact of the matter is that the granting

*Reversed on appeal on other grounds 105 F. (2d) 962.

by the Patent Office of the Wheeler reissue was not in any sense a review or setting aside of the decision of the Second Circuit Court of Appeals in the *Abrams* case. On the contrary, the Patent Office in granting the reissue gave full faith and credit to the decision in the Second Circuit, of which it was fully apprised (see Findings 8 and 9, R. 842), and the effect of the reissue was to restrict the scope of the asserted monopoly so that it no longer embraced the relatively basic subject matter which the Second Circuit Court of Appeals held to be unpatentable.

The reissue patent here involved is a narrowing reissue of the not unusual type in which, following a court decision that broadly claimed subject matter of the original patent is invalid for lack of novelty or lack of invention, the asserted monopoly is restricted by reissue to a more specific combination or arrangement disclosed but not adequately claimed in the original patent.

The propriety of a reissue in such a case, under the express language of the statute,* was recognized by Judge Brown in *Mathews v. Flower*, 25 Fed. 830, 831-2. A like conclusion was reached by the Second Circuit Court of Appeals in an opinion written in 1898 by Judge Shipman in *Maitland v. B. Goetz Mfg. Co.*, 86 Fed. 124, 128.** Since that time the Second Circuit Court of Appeals has upheld reissued patents, after decisions holding claims of the original patent invalid for lack of novelty or invention, in *Edison v. American Mutoscope, etc., Co.*, 151 Fed. 767, and in *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 18 F. (2d) 66, certiorari refused at 274 U. S. 753. The First Circuit Court of Appeals has upheld and applied this view in *Frink Co. v. Erikson*, 20 F. (2d) 707, 712.

*R. S. 4916, U. S. Code, Title 35, Sec. 64.

**The reissue patent involved in that case was subsequently held invalid by the Third Circuit Court of Appeals on the ground of intervening rights and departure from the original disclosure, with one judge dissenting, in *Horn & Brannen Mfg. Co. v. Pelzer*, 91 Fed. 665, 668-70.

Its propriety was also recognized by the Sixth Circuit Court of Appeals in *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 276 Fed. 234,—a case very closely analogous to the instant case (See R. 1473-4). The Seventh Circuit Court of Appeals also sustained a reissue under the same circumstances in *Fehr v. Activated Sludge*, 84 F. (2d) 948, 949-51. The Third Circuit case of *Penn Electrical & Mfg. Co. v. Conroy*, 185 Fed. 511, was referred to by petitioner in its presentation of the instant case in the Sixth Circuit Court of Appeals as support for the proposition which petitioner now seeks to have this Court take up on certiorari. But there is no conflict between that case and the consistent course of the authorities in the other circuits, as was pointed out by Judge Allen in the instant case (R. 1472-3), by Judge Morris, speaking for the First Circuit Court of Appeals in *Frink Co. v. Erikson*, 20 F. (2d) at page 712, and by Judge Learned Hand in the opinion of the Second Circuit Court of Appeals in *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 18 F. (2d) at page 69.

III. The decision of the Sixth Circuit Court of Appeals does not sanction any abuse of the reissue statute or present a matter of outstanding importance in the administration of patent law.

It is difficult to take seriously the assertion of petitioner's counsel (petition p. 12-13) that the "inadvertence, accident or mistake" in the original patent was "created solely and *nunc pro tunc* by the adverse decision of the Court of Appeals for the Second Circuit." The *defect or insufficiency* of the original patent may be said to have been disclosed and established by the decision of the Second Circuit Court of Appeals, but the *inadvertence* lay in Wheeler's unintentional acceptance, without fraudulent or deceptive intention, of original claims which were not

commensurate with the invention disclosed in the specification but embraced more than he had a right to claim as new. In holding that such circumstances constitute inadvertence within the meaning of the statutes the Sixth Circuit Court of Appeals relied upon its own former decisions in *American Automotoneer Co. v. Porter*, 232 Fed. 456, 460, and *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 276 Fed. 234, 238 (R. 1475). Respondent's counsel do not suggest that this line of decision is in conflict with any decision of this Court or with any decision of any other Court of Appeals. It is in accord with the following decisions:

Topliff v. Topliff, 145 U. S. 156, 171-2; *Motion Picture Patents Co. v. Laemmle* (D. C., S. D. N. Y.), 214 Fed. 787, 794; *Iowa Washing Machine Co. v. Montgomery Ward & Co.* (D. C., S. D. N. Y.), 227 Fed. 1004, 1007, affirmed (C. C. A. 2) 234 Fed. 88, 89; *Robert v. Krementz* (C. C. A. 3), 243 Fed. 877, 881; *Crown Cork & Seal Co. v. Aluminum Stopper Co.* (C. C. A. 4), 108 Fed. 845, 853; *Fehr v. Activated Sludge* (C. C. A. 7), 84 F. (2d) 948, 950-951; *Perfection Disappearing Bed Co. v. Murphy Wall Bed Co.* (C. C. A. 9), 266 Fed. 698, 699, certiorari denied—254 U. S. 652.

In their argument on this Point III, petitioner's counsel urge (pp. 13-14) that plaintiff was guilty of laches because it did not disclaim the broader subject-matter when it "was apprised of the defects in the original patent by the answer of the defendant in the New York litigation; and again by the adverse decision of the District Court". It goes without saying that "the answer of the defendant in the New York litigation" did not put upon the plaintiff the duty to disclaim, and the very case cited by petitioner (*Ensten v. Simon, Ascher & Co.*, 282 U. S. 445) held that "When the District Court in Ohio declared claim 2 invalid, the owner of the patent might have appealed to the Circuit Court of Appeals within thirty days" (p. 455).

In the *Abrams case* plaintiff did appeal within thirty days (R. 839, Finding 2). Its right to proceed in this way is confirmed by the decision of this Court in *Triplett v. Lowell*, 297 U. S. 638, upon which the Sixth Circuit Court of Appeals relied in the instant case (R. 1475-6).

Conclusion

It is submitted that there is no conflict between the decision of the Circuit Courts of Appeals for the Second and Sixth Circuits and that there is no new or important question for this Court to consider. The case is merely the usual patent infringement suit involving a reissue patent and it seems to us from the statement on page 8 of petitioner's brief as to the questions which it would like to raise before this Court, that the petitioner is merely attempting to get the case before this Court so that petitioner will have the opportunity to argue over again all of the questions which have been ruled against it both in the Trial Court and in the Court of Appeals.

Respectfully submitted,

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Counsel

January 21, 1941